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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Judy McCutchin
v.
Jan DuBell.

Opposition No. 91156821
to application Serial No. 78105321

Kurt Koenig of Koenig & Associates for Judy McCutchin.

Jan DuBell, pro se.

Before Hairston, Walters, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 28, 2002, Jan DuBell (applicant) applied to register the mark BIG "D" REAL ESTATE (standard character form) on the Principal Register for "real estate brokerage" services in Class 36. Serial No. 78105321. The application contained a disclaimer of the term "Real Estate" and an allegation of a date of first use of May 1, 1999, and a date of first use in commerce of June 22, 2000.

On May 23, 2003, Judy McCutchin (opposer) filed a notice of opposition on the ground that the "phrase 'BIG D' is synonymous with the city of Dallas, Texas. 'BIG D' is

commonly used and known to refer to Dallas. When 'BIG D' is used in conjunction with the remaining portion of the Mark, namely, 'REAL ESTATE,' for use on 'real estate brokerage' services, the mark is highly descriptive." Notice of Opposition at 2. Opposer further maintains that "Applicant's registration of the descriptive phrase 'BIG 'D' REAL ESTATE' is akin to the United States Patent and Trademark Office granting a monopoly in a geographic term." Id. Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application and eleven notices of reliance filed by opposer and twenty-two notices of reliance by applicant¹ concerning various printed materials from newspapers, magazines, and other sources. Applicant has also moved to strike opposer's eleven notices of reliance on numerous grounds. Regarding the second, third, and fourth notices of reliance, applicant objects on the ground that they do "not meet the procedural requirements of Rule 2.122(e)." ² In her brief (unnumbered page 10), applicant argues that she "is not familiar with

¹ In an Order dated July 23, 2004 at 3, the board struck applicant's fifth, sixth, ninth, tenth, eleventh, thirteenth (except for Exhibit B), seventeenth, and twenty-second notices of reliance.

² The July 23, 2004, board order (p. 2) denied applicant's motions to strike all of opposer's notices on the ground of untimeliness.

the source, 'Nexis' articles submitted by Notice of Reliance." The TBMP (§ 704.08) provides that "[i]n lieu of the actual 'printed publication or a copy of the relevant portion thereof,' the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion, as, for example, by a printout from the NEXIS computerized library of an article published in a newspaper or magazine of general circulation."³ Therefore, we overrule all of applicant's objections to opposer's NEXIS evidence, i.e., second, third, fourth, and sixth through eleventh notices of reliance.⁴ We add that the sixth, seventh, and eight notices of reliance consist primarily of NEXIS printouts of wire service stories. While we will consider these wire service printouts, we give them decidedly less weight, and, in fact, we find them to be cumulative. In re Cell Therapeutics Inc., 67 USPQ2d 1795, 1798 (TTAB 2003) ([W]hile we are not saying that newswire stories are of the same probative value as are stories appearing in magazines and newspapers, we think that the situation has changed such

³ "NEXIS is a computerized database containing articles in text-only format from hundreds of periodicals spanning many years." New York Times Co. v. Tasini, 533 U.S. 383, 59 USPQ2d 1001, 1002 (2001).

⁴ Applicant's brief (unnumbered page 10) maintains that "Opposer has actually edited text in 'Nexis' articles submitted by Notice of Reliance." Applicant does not explain this point or discuss any specific examples. Inasmuch as we cannot discern any irregularities, we will consider these NEXIS printouts.

that said newswire stories have decidedly more probative value than they did when this Board decided the Professional Tennis Council [In re Men's International Professional Tennis Council, 1 USPQ2d 1917, 1918 n.5 (TTAB 1986)] and Appetito Provisions [In re Appetito Provisions Co., 3 USPQ2d 1553, 1555 n.6 (TTAB 1987)] cases").

Applicant also objects to the documents concerning applicant's website that are included with opposer's first notice of reliance. Extracts from websites are not normally appropriate for submission by a notice of reliance. TBMP § 704.08 (2d ed. rev. 2004) ("The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed from the Internet"). However, there is an exception if the documents were produced in response to interrogatories or requests for admission. 37 CFR § 2.120(j)(3)(i). Opposer maintains that "the website was provided as part of the Applicant['s] Response to Interrogatories and Applicant['s] Admissions by Applicant and is admissible." Opposer's opposition to motion to strike at 3. While the website address may have been provided in response to interrogatories and requests for admissions, we note that at least some of the website printouts are dated "3/30/04 9:26 AM." Inasmuch as "Opposer's First Notice of Reliance" is dated April 9, 2004 (10 days later), it does not appear that those particular

documents were submitted in response to a request for admissions or interrogatories. Furthermore, opposer did not comply with the provisions of Rule 120(j)(3)(i) inasmuch as she did not file a "copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto ... together with the notice of reliance." Therefore, we agree with applicant that the documents in opposer's first notice of reliance are not properly authenticated and we will not consider them.

Finally, we overrule applicant's objection to the exhibits in opposer's fifth notice of reliance on the ground that they do "not meet the procedural requirements of Rule 2.122(e)." These documents were properly submitted under 37 CFR 2.120(j)(3)(i).

Standing

Applicant admits that "Judy McCutchin ('Opposer') is a licensed real estate agent only in the State of Texas. Opposer sells residential real estate in Dallas, Texas." Opposer is a competitor of applicant." TBMP § 704.06(b) (2d ed. rev. 2004). Applicant is also a real estate broker in Dallas, Texas. Opposer's Fifth Notice of Reliance, Exhibit C, Admission 10 (Applicant admitted, inter alia, that its website states that "we offer extensive [r]elocation assistance for companies and individuals locating into or

out of Dallas. Experts in Residential and Ranch properties, we have over 20 years combined experience in Dallas real estate").

It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses... Thus, opposer as a competitor of applicant is a proper party to challenge applicant's right of registration.

Federal Glass Co. v. Corning Glass Works, 162 USPQ 279, 282-83 (TTAB 1969). See also McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:11 ("Standing is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business").

Inasmuch as opposer is a competitor of applicant who would have an interest in using the term "Big 'D' Real Estate," opposer has standing to oppose this application. In addition, opposer does not need to prove priority in this case because the issue is geographical descriptiveness.

Remington Products Inc. v. North American Philips Corp., 892

F.2d 1576, 13 USPQ2d 1444, 1449 (Fed. Cir. 1990) ("There is one point on which we fully agree with the board. It appears in footnote 6 of the board opinion and reads: The emphasis each party has given to the first use of 'TRAVEL CARE' by defendant in terms of priority is not warranted. The issue here is descriptiveness ... and therefore priority of use is not an element in proving the case"). Also, opposer does not need to show it is using the mark. "It is enough to show such interest as will justify the conclusion that damage to it will ensue if the use of such term by it or its customers to describe their goods is denied." Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 805, 120 USPQ 293, 294 (CCPA 1959).

Issue

In its brief (p. 5), opposer sets out the issue as follows: "whether the mark sought to be registered, namely, 'BIG D REAL ESTATE' (with 'real estate' disclaimed) is the name of a place generally known to the public and that the public would make a services/place association." Applicant argues (Brief at unnumbered p. 10) that "'BIG D' alone has not been proven to solely denote any particular service or location."⁵ Therefore, the only question is whether

⁵ Applicant also argues (Brief at unnumbered p. 10) that she is "the exclusive user of the phrase 'BIG D' in connection with the words 'REAL ESTATE' in commerce and has acquired distinctiveness for her business name." However, applicant has not made the question of her mark's acquired distinctiveness an issue by

applicant's mark "BIG 'D' REAL ESTATE" for real estate brokerage services "is primarily geographically descriptive" of these services. 15 U.S.C. § 1052(e)(2).

The Board has set out the following test to use in determining whether a mark is primarily geographically descriptive:

[T]he Trademark Examining Attorney would need to submit evidence to establish a public association of the goods with that place if, for example, a genuine issue is raised that (1) the place named in the mark may be so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied or (2) an admitted well-recognized term may have other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. Where, on the other hand, there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's own goods come from the geographical place named in the mark.

In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849-50 (TTAB 1982).

We begin by noting that the evidence does not show that there is a city known officially as "Big D." Instead, the question is whether "Big D" is a nickname for Dallas, Texas, and therefore, equally primarily geographically descriptive.

In re Charles S. Loeb Pipes, Inc., 190 USPQ 238, 246 (TTAB

asserting an affirmative defense. Colonial Arms Corp. v. Trulock Firearms Inc., 5 USPQ2d 1678, 1680 n.5 (TTAB 1987). Nor was the issue tried by consent. Therefore, we will not consider this issue raised in applicant's brief.

1975) ("It is clear from the foregoing that nicknames and even abbreviations and maps of geographical areas and the names of the geographical area that they identify are, for purposes of registration, identical, and that the same criteria for registration must necessarily apply thereto").

Opposer has submitted numerous printouts to show that "Big D" is a recognized nickname for Dallas. A sample of this evidence (emphasis added) is set out below.

DALLAS IS LOW ON LIST OF 'MARKETS TO WATCH':
Even Baltimore and Philadelphia are better bets than **Big D**, if you buy the survey results. Dallas also ranks behind all the other Texas cities in the survey.
Dallas Morning News, October 26, 2001.

Big D attracts an estimated 13 million visitors annually - 40 percent of whom come for business, said Greg Elam, senior vice president of communications for the Dallas Convention and Visitors Bureau.
Dallas Morning News, June 3, 2001.

Big D used to mean Big T. During the 1970s and mid-80s, World Championship Tennis, the Virginia Slims women's tour and the Association of Tennis Players were all based in the Dallas area.
Dallas Morning News, May 6, 2001.

Dallas, as well as many other communities, followed the technology tide to become one of the nation's leading cyber cities ... The "**Big D**" did not make its paradigm shift from an energy-based economy to a technology hub without error...
Tulsa World, April 11, 2001.

Officials are extolling Dallas' cosmopolitan virtues, as well as feeding the **Big D** pop culture image with a gala dinner Monday at the Southfork Ranch Ewing Mansion.
Fort Worth Star-Telegram, March 6, 2001.

The agreement is expected to be formally announced this week, Amtrak officials said Tuesday. No start date or

ticket prices have been set for daily passenger service on the "Crescent Star" between **Big D** and the Big Apple -- the first direct service from Dallas to New York in at least 40 years.

Dallas Morning News, February 7, 2001.

Mr. Monger began buying depressed rental real estate in Dallas, where he came to visit friends. He spent his weekends in **Big D** as a "de-slum" landlord, renovating his properties.

Dallas Morning News, October 15, 2000.

With flight delays on the rise this year at large airports around the country, they and thousands of other air travelers are taking advantage of an alternate way to get in and out of **Big D**: Dallas Love Field.

Dallas Morning News, September 24, 2000.

Big game in **Big D**: Oklahoma and Texas play Saturday in Dallas, and this year's hype appears legitimate.

Daily News of Los Angeles, October 5, 2000.

Going to **Big D**: Ponciano said an agreement was reached for the Matadors to play against Division I Southern Methodist next November. SMU will pay the Matadors \$125,000 to make the trip to Dallas.

Daily News of Los Angeles, November 8, 1998.

Westwood: You should be warmly embraced in Denver.

One of the city's nicknames is "D-TOWN."

Kyle Gass: Excellent. Dallas's nickname is "the **Big D**," which was nice, 'cause I'm really into O-Town right now.

Denver Westwood, April 23, 2001.

The question is whether anyone in Dallas has noticed.

Big D and environs are Cowboy country.

Denver Westwood, October 3, 1996.

In fact, prior to 2000 Dallas led the Texas film pack. That year Austin surged ahead with its best year to date behind almost \$125 million in film projects, while **Big D** had about \$89 million.

Austin American-Statesman, September 5, 2003.

Big appetites in **Big D**

Dallas Cowboy's owner Jerry Jones pitched in a recipe for salmon croquettes.

Austin American-Statesman, January 8, 2003.

For example, Dallas is home to JC Penney and most of its advertisements are shot in **Big D**.

Austin American-Statesman, October 20, 2002.

Big trouble in **Big D** for Big Don and Little Donnie: Don Nelson still had a little of his reputation left when he arrived in Dallas, not that it lasted long.

Austin American-Statesman, January 8, 2000.

The evidence of record establishes that Dallas is not an obscure place and that "Big D" is a common nickname for Dallas.

Furthermore, we note that much of applicant's business is conducted in the City and County of Dallas. Applicant admits that her "main office happens to be located in the Dallas, Texas metro area" and that she "is involved in the North Texas real estate market, among other places, and is a member of the Greater Dallas Board of Realtors."

Applicant's Brief at 5 and 7. Applicant also responded to opposer's request for admissions as follows:

On applicant's website located at www.bigdrealestate.net, "around BIG D" is immediately followed by computer links entitled "Dallas Chamber of Commerce," "Dallas Convention & Visitors Bureau," "Locate Dallas Properties," Dallas Area Aerial Photos," "Dallas Morning News," "Dallas Photos," "Dallas Schools," "Dallas Weather," and "Texas, Our Texas."

Response: ADMIT, because Applicant's website has many resources features and links which may be of interest to those seeking applicant's services.

Opposer's Fifth Notice of Reliance, Exhibit A.

Applicant's website located at www.bigdrealestate.net features the following notation: "Big D Real Estate™ provides full coverage if the Dallas metropolitan area

and surrounding North Texas counties. We are intimately acquainted with all aspects of life in Dallas/Fort Worth and we pride ourselves in our knowledge of this thriving cosmopolitan area. At BIG D Real Estate™ we offer extensive Relocation assistance for companies and individuals relocating into or out of Dallas. Experts in Residential and Ranch properties, we have over 20 years combined experience in Dallas real estate. Let our knowledgeable BIG D™ agents help you create a worry free real estate transaction."

Response: ADMIT, because Applicant's website has many resources features and links which may be of interest to those seeking applicant's services. Applicant's website is located in the Dallas, Texas area and is included for identification purposes. The site is intended, and has resulted in business relationships all over the United States and is displayed internationally.

Opposer's Fifth Notice of Reliance, Exhibit C.

The record supports a conclusion that at least a significant portion of applicant's brokerage services are focused on and located in Dallas, Texas. A public association of the goods with the place may ordinarily be presumed from the fact that the applicant's own goods come from the geographical place named in the mark. Handler Fenton Westerns, 214 USPQ at 850. The same rule applies for services. Indeed, FOUNTAIN HILLS was held to be geographically descriptive for the real estate services located in Fountain Hills, Arizona.

If a term names an obscure or remote place, an association between the term and particular goods or services may not be made. Applicant's argument that Fountain Hills, Arizona must be widely recognized all across America in order for the refusal to register to be proper under Section 2(e)(2) is not well taken, however. Whether there is an association between the name of the place and the services is determined not in

the abstract, but rather in connection with the services with which the mark is used, and from the perspective of the relevant public for those services. In the case at hand, the relevant purchasing public for applicant's service of developing real estate includes people considering purchasing real property in Fountain Hills, Arizona. Whether or not they presently live in Arizona, these people are aware (or will become aware) of the fact that "Fountain Hills" is the name of that place where applicant is located, that is, the town promoted by applicant as a wonderful place to buy real estate. In the context of applicant's services, the place is not obscure or remote. A clearer association between these services and this place name is difficult to imagine.

In re MCO Properties Inc., 38 USPQ2d 1154, 1156 (TTAB 1995).

Similarly, when prospective customers in Dallas, Texas, encounter "BIG D Real Estate" brokerage services an association between the services and the place name is clear.

Opposer's evidence has established its prima facie case that there is a public association of the term "Big D" with Dallas, Texas. Applicant argues (Brief at unnumbered page 7) that there "have been no formal surveys, public polls, or other professional research to determine that any percentage of the population relates the phrase 'BIG D' only to Dallas, Texas." Such evidence is not required. Accord Goodyear Tire & Rubber Co. v. Continental General Tire Inc., 70 USPQ2d 1067, 1079 n.29 (TTAB 2003) (citation omitted) ("As applicant argues, it is true that opposer has not provided survey evidence about the perceptions of ordinary consumers when faced with the term "intelligent" when used in

connection with tires. However, evidence of the relevant public's understanding can be obtained from newspapers, magazines, trade journals and other publications without demonstrating the effect of this evidence on the consuming public. There is nothing in trademark law or practice that requires a plaintiff to offer up a survey to support an allegation of descriptiveness").

One of applicant's main arguments is that, in effect, a well-recognized term may have other meanings "such that the term's geographical significance may not be the primary significance to prospective purchasers." Handler Fenton Westerns, 214 USPQ at 850. Applicant has submitted numerous documents to show that many entities throughout the United States incorporate the term "Big D" as part of their trade or business names. See, e.g., Applicant's second notice of reliance (Kansas - Big D Oil Co., Big D Farms Inc.; Kentucky - Big D Mart Inc., Big D Mining Co. Inc.; Louisiana - Big D Farms Inc., Big D Seafood; Maine - Big D Video Plus Inc.). Applicant also identifies articles in which the term "Big D" refers to something other than Dallas. See, e.g., Applicant's eighth notice of reliance (*Neighborhood News*, November 5, 1998 - "State Rep. Margaret Long had predicted Tuesday morning that her 38th District seat in the Kansas House would continue bearing the label of a 'Big D' - for Democrat - after the votes were counted"); *New York Times*,

October 8, 2002 - "That Big D in Devils still stands for Defense").

In order for a term to be *primarily* geographically descriptive, the term does not have to be "solely geographic" as applicant suggests. Brief at unnumbered p. 7. Indeed, if that were the case, many well-known geographic locations would not be geographically descriptive. This is not what our case law holds.

Applicant urges that London is not primarily geographical because the word has other meanings and usages and because there are a number of other towns named London, but the other meanings and usages are minor and obviously derived from the geographical meaning, and the existence of other towns named London does not deprive the word of its primary geographical meaning. Applicant also urges that London is used as a surname, but this is of no moment. I do not see that there can be any reasonable argument that the word London is not primarily geographical.

In re London Gramophone Corp., 98 USPQ 362, 363 (Ex. Chief 1953). See also In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694, 1697 (TTAB 1992) (While London has surname significance, it remains geographically descriptive); In re The Cookie Kitchen, Inc., 228 USPQ 873, 874 (TTAB 1986). ("Even if the listings it submitted are accepted as fact, all they show is that there is cocktail known as a Manhattan and that various kinds of businesses in various places incorporate "MANHATTAN" as one part of multiple-part trade names. This simply does not rebut the prima facie case made by the Examining Attorney"). Similarly, the evidence does

not convince us that the numerous references to various Big D businesses would have any substantial impact on purchasers in the United States that would detract from the Dallas, Texas significance of the term. Simple listings of Dun & Bradstreet reports and telephone books do not prove that they have much impact on prospective purchasers.⁶

Certainly, when the term "Big D" is used in association with real estate services in Dallas, Texas, we are convinced that the term would primarily geographically describe the fact that the services are rendered in Dallas.

Finally, we add that the "addition of a generic term to a geographic term does not avoid the refusal of primary geographic descriptiveness." In re Carolina Apparel, 48 USPQ2d 1542, 1543 (TTAB 1998). Here, the addition of the generic and disclaimed term, "real estate," to "Big D" used in association with real estate brokerage services does not take away the primarily geographically descriptiveness of the mark.

Decision: The opposition is sustained.

⁶ Even if some customers may believe that "the phrase 'BIG D' relates to Applicant's last name 'DuBell'" as applicant asserts in her brief (unnumbered p. 7), the term particularly in Texas would remain geographic.